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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

of Correction

## MAIL STOP PETITION

FAX TO 703-872-9306

Patent No.	6,550,701
Patent Issued:	April 22, 2003
Application No.	09/684,777
Filing Date:	October 10, 2000
Inventor:	CHANG, Frank
Assignee:	MICHILIN PROSPERITY CO., LTD.
Title:	DUAL-FUNCTIONAL MEDIUM SHREDDING MACHINE STRUCTURE
Attorney Ref:	CHAN3272/TJM

RE-SUBMISSION BY FACSIMILE OF  
PETITION TO THE DIRECTOR

Director of the United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Submitted herewith is a copy of the Petition filed April 19, 2005, and the receipt card that evidences the filing of the same. This facsimile submission today, is at the suggestion of the Petitions Office. The undersigned telephoned the Petitions Office today, and inquired why the PAIR does not yet show the Petition filed on April 19, 2005. It was suggested that the Petition be re-submitted by facsimile.

BACON & THOMAS, PLLC  
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Date: May 5, 2005

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Respectfully submitted,



Thomas J. Moore  
Attorney for Petitioner

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Patent No.	6,550,701
Patent Issued:	April 22, 2003
Application No.	09/684,777
Filing Date:	October 10, 2000
Inventor:	CHANG, Frank
Assignee:	MICHILIN PROSPERITY CO., LTD.
Title:	DUAL-FUNCTIONAL MEDIUM SHREDDING MACHINE STRUCTURE
Attorney Ref:	CHAN3272/TJM

**PETITION TO THE DIRECTOR**

Director of the United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This Petition is filed under 37 C.F.R. §1.182 to reverse the decision stated in the Official Action (copy attached and labeled as "Exhibit A to Petition filed April 19, 2005", and referred to below as the "Official Action"), which decision denies the "Request for Certificate of Correction under 37 CFR §1.322" (copy attached and labeled as "Exhibit B to Petition filed April 19, 2005", and referred to below as the "Request"). If it is determined that any other rule is applicable to this Petition, then consideration may be construed under such other rule. This Petition is to the "Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office" (referred to below as the "Director") in accord with the rules.

Submitted herewith is payment of the \$400.00 U.S. government fee which is set by 37 C.F.R. §1.17(f). In addition, there is an authorization to charge any required fees to a deposit account in the penultimate paragraph of the Petition.

This Petition arises based primarily on two events. First, the Examiner erroneously failed to require that original Claim 4 be rewritten in independent format when he allowed the case on first action. Claim 4 is dependent on Claim 1. Claim 1 recites two switches, but Claim 4 recites "a

**PETITION TO THE DIRECTOR  
U.S. Patent No. 6,550,701**

single touch switch." Thus, Claim 4 literally has one less element than Claim 1. Only one switch is required (see the patent at column 4, line 32 and following). Second, the Official Action erroneously denies the Request as follows:

In the claims, (claim 4) Per Examiners request. Corrections not appropriate for Certificate of Correction. Reissue needs to be filed if changes needed. "Therefore, no correction(s) is in order here under United States Code (U.S.C.) 254 and the Code of Federal Regulation (C.F.R.) 1.322." ["1322" corrected to read "1.322"].

The Official Action cites no statutory or case law to support the allegation that correction is "not appropriate" and that a reissue needs to be filed. The statutory and case law is to the contrary. Correction of all errors by the U.S. Patent and Trademark Office is within the scope of 35 U.S.C. §254, including an error of improper format a claim. Indeed, the corresponding rule even allows for the grant of a "corrected patent" as follows: "If the nature of the mistake on the part of the Office is such that a certificate of correction is deemed inappropriate in form, the Director may issue a corrected patent in lieu thereof as a more appropriate form for certificate of correction, without expense to the patentee." 37 C.F.R. §1.322(b).

**INTRODUCTION**

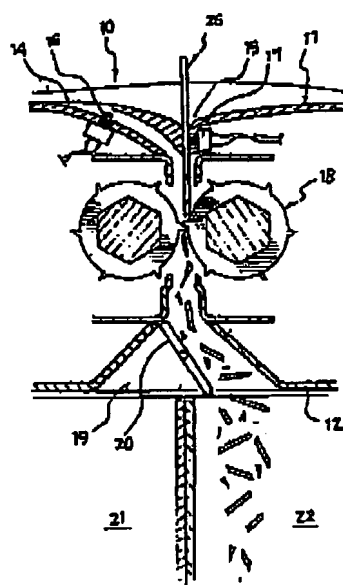
The technology of the patent may be described as a two switch/two bin embodiment, and a one switch/one bin embodiment. The two switch/two bin embodiment comprises a paper scrap bin and a disc scrap bin. See for example, numerals 21 and 22 at the bottom of Figure 3. The patent describes a shredding machine that shreds both paper and discs. These discs may be CD-ROM's containing electronic data. In the two switch/two bin embodiment of the invention, one bin is for the scraps of paper that are produced by the shredding, and the other bin is for the scraps of the discs that are produced by the shredding. The patented machine automatically dispenses the shredded scraps into the correct bin. This is accomplished by the two switches. When a user

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**U.S. Patent No. 6,550,701**

feeds a disc into the shredder, a switch detects the disc and moves the switch blade so that the scraps from shredding are deposited in the disc scrap bin.

For example, in Figure 3, the switch numbered 17 at the top of the Figure detects the disc noted by the numeral 26 at the top of the Figure, and positions the switch blade numbered 20 so as to force the scraps into a disc scrap bin numbered 22 at the lower right. In contrast, when a user feeds a piece of paper into the shredder, then another switch detects the paper. This switch is numbered 16 at the upper left. The scraps of paper from the shredding are forced into paper scrap bin 21, which appears at the lower left.

U.S. Patent Apr. 22, 2002 Sheet 3 of 4 US 6,550,701 B1



**Fig. 3**

The patent teaches that some customers may prefer a one switch/one bin embodiment because of lower cost. As stated in column 4, lines 40-44, "a simplified embodiment of this invention further reduces the number of components thereby reducing the manufacturing cost and enhancing competitiveness." In this simplified and more cost effective embodiment, the number of switches may be reduced to one, the switch plate may be completely eliminated, and the driving mechanism for the switch plate may be completely eliminated. See, for example, column 4, lines 30-35.

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The patented invention is a shredding machine that shreds both paper and discs with only two roller blades. The most cost effective embodiment is the one switch/one bin embodiment. The more costly version is the two switch/two bin embodiment. Both allow a customer to purchase a single shredder and then shred either paper or discs, in order to keep personal information confidential.

**CLAIM 4 HAS AN ERROR IN FORMAT  
BECAUSE IT IS WRITTEN IN DEPENDENT FORMAT  
RATHER THAN INDEPENDENT FORMAT**

Claim 4 of the patent is directed to the one switch/one bin embodiment, because it recites "a single touch switch is provided between the roller blades such that regardless of the type of substance being fed by a user, the paper, disc, or credit cards can all touch the touch switch so as to activate the roller blades to perform the shredding task while the scraps are all dispensed to an identical bin." See the patent at column 6, lines 10-15. Claim 4 has an error in format because it is written as a claim dependent upon Claim 1.

Claim 4 recites a "single" switch of the one switch/one bin embodiment. It appears that the Examiner clearly misunderstood Claim 4. The failure of the Examiner to require Claim 4 to be rewritten in independent format is a fundamental error. The patent law provides that "a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed." 35 U.S.C. §112. Claim 1 recites two switches. Claim 4 recites a "single" switch. Claim 4 does not include a further limitation. Rather, Claim 4 removes a limitation. The Examiner clearly should have required the patent applicant to rewrite Claim 4 in independent format. This error is not disputed by the Official Action which denies the Request.

The U.S. Patent and Trademark Office provides guidance to Examiners in the Manual of Patent Examining Procedure, which is more commonly known as the MPEP. The following are provisions relevant to the examination of Claim 4 of the patent:

**PETITION TO THE DIRECTOR**  
**U.S. Patent No. 6,660,701**

Where a claim in dependent form is not considered to be a proper dependent claim under 37 CFR 1.75(c), the examiner should object to such claim under 37 CFR 1.75(c) and require cancellation of such improper dependent claim or rewriting of such improper dependent claim in independent form. See *Ex parte Porter*, 25 USPQ2d 1144, 1147 (Bd. of Pat. App. & Inter. 1992) (A claim determined to be an *improper dependent claim should be treated as a formal matter*, in that the claim should be objected to and applicant should be required to cancel the claim (or replace the improper dependent claim with an independent claim) rather than treated by a rejection of the claim under 35 U.S.C. 112, fourth paragraph.). The applicant may thereupon amend the claims to place them in proper dependent form, or may redraft them as independent claims, upon payment of any necessary additional fee.

Manual of Patent Examining Procedure (MPEP) §608.01(n) (Original Eighth Edition, August 2001, May 2004) (emphasis added) at page 600-80. This is further explained with an example.

Thus, for example, if claim 1 recites the combination of elements A, B, C, and D, a claim reciting the structure of claim 1 in which D was omitted or replaced by E would not be a proper dependent claim, even though it placed further limitations on the remaining elements or added still other elements.

*Id.* (emphasis added).

The Director should prevent manifest injustice by issuing the Certificate of Correction which corrects Claim 4 into independent format to read as follows:

4. A dual-functional medium shredding machine structure, *that allows shredding of paper, optical discs, and credit cards, characterized in comprising:*

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U.S. Patent No. 6,550,701**

*a machine body being provided with a power switch on a surface thereof and roller blades therein, the roller blades being driven by a gearbox;  
two inports on an upper lid thereof, the inports including a paper inport with an opening of a larger dimension and inclined, curved channel walls, and a disc inport with an opening of a smaller dimension and vertical channel walls, the inports being each led to the shredding roller blades such that, regardless of the type of substance being fed by a user, the paper or the disc can all be shredded by the shredding roller blades through the intermeshing of roller blades; and  
a single touch switch is provided between the roller blades such that regardless of the type of substance being fed by a user, the paper, disc, or credit cards can all touch the touch switch so as to activate the roller blades to perform shredding task while the scraps are all dispensed to an identical bin.*

The words in italics above are the words taken from Claim 1, in order to replace the phrase "of Claim 1," which appears in Claim 4 as originally filed.

**THE CORRECTION IS NOT SUBJECT TO REASONABLE DEBATE  
BASED ON THE CLAIM LANGUAGE AND THE SPECIFICATION**

The correction of Claim 4 of the patent is not subject to reasonable debate. Claim 1 literally recites two switches. Claim 4 is dependent upon Claim 1, but recites "a single touch switch" that replaces the two touch switches in Claim 1. This is in accord with the description of the invention in the specification. The specification clearly teaches a two switch/two bin embodiment which requires two switches because the shredded material must be directed into the appropriate bin. The specification also teaches a single switch/single bin embodiment which reduces the number of switches to one, uses only a single output bin, and does not need the mechanism associated with the two bin embodiment. The MPEP is clear that a dependent claim cannot broaden the claim upon which it depends. This is consistent with the statute. Thus, it was clearly error for the

**PETITION TO THE DIRECTOR  
U.S. Patent No. 6,550,701**

Examiner to allow Claim 4, without requiring that the format of Claim 4 be changed from dependent into independent. This is a mere change in format, as made clear by the MPEP.

**THE PROSECUTION HISTORY DISCLOSES  
A CLEAR ERROR BY THE EXAMINER**

The prosecution history is brief because the application was allowed in the first Official Action. There was never any rejection or objection. The first Official Action discloses a clear error by the Examiner. The Examiner overlooked the fact that Claim 4 reduces the number of limitations, as compared to Claim 1. This is indicated by the failure of the Examiner to require that Claim 4 be rewritten in Independent format. This is confirmed by the following statement on the page immediately following the Notice of Allowability:

The following is an examiner's statement of reasons for allowance: The art of record, considered alone or in combination, neither anticipates nor renders obvious a dual function medium shredding machine for shredding paper, optical discs and credit cards comprising a paper touch switch and a disc touch switch to activate roller blades to perform an intermeshing and shredding task in combination with the rest of the claimed limitations.

The fact that this statement includes reference to both "a paper touch switch and a disc touch switch" indicates that the Examiner erroneously viewed Claim 1 as the broadest claim, and failed to understand that Claim 4 is the broadest claim. Claim 4 recites a "single touch switch" which is obviously broader than the recitation of two switches in Claim 1. The Certificate of Correction would remedy this error.

**PENDING LITIGATION**

The patent is involved in a pending civil action: Michilin Prosperity Co., Ltd. v. Fellowes, Inc., Case No. 04-1025 (RWR/JMF) (U.S. Dist. Ct., D.D.C.). All documents filed in the case are



**PETITION TO THE DIRECTOR  
U.S. Patent No. 6,550,701**

available for download from the publicly available online PACER database because the United States District Court for the District of Columbia requires electronic filing. The Court is currently considering a number of pretrial motions.

There is no description of a third switch in the patent. This fact is mentioned solely because an adversary in the litigation asserts there is such a third switch. As clearly disclosed by the patent, you need only one switch for each bin. If you manufacture the embodiment with two bins, then you need two switches. On the other hand, if you manufacture the embodiment with one bin, then you only need one switch.

**AN INFORMATION DISCLOSURE STATEMENT IS NOT REQUIRED**

The rules do not require an Information Disclosure Statement (IDS) when a Request for Certificate of Correction is filed, and when a Petition such as the present one is filed.

The reference to "subject to such other requirements as may be imposed," in 37 C.F.R. §1.182, cannot be construed to require an IDS absent an express requirement by the Director. This is mentioned because an additional search was conducted, and additional prior art was reviewed, before the filing of the lawsuit described above.

**DEPOSIT ACCOUNT AUTHORIZATION**

The Director is authorized to charge to deposit account no. 02-0200, any U.S. government fee that is required to process this Petition, and to credit any overpayment to deposit account no. 02-0200.

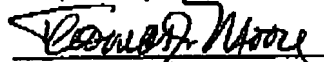
**PETITION TO THE DIRECTOR**  
**U.S. Patent No. 6,550,701**

**CONCLUSION**

The grant of the Certificate of Correction, or in the alternative, a "corrected patent" under 37 C.F.R. §1.322(b), is respectfully requested.

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Date: April 19, 2005  
SV:Producer/Grp/Hep/CHAN3272/Petition 2005 04 19 wpd

Respectfully submitted,

  
Thomas J. Moore  
Felix J. D'Ambrosio  
Attorneys for Petitioner

**Exhibit A to Petition filed April 19, 2005 (U.S. Pat. No. 6,550,701)****UNITED STATES PATENT AND TRADEMARK OFFICE**

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

Date Mailed : 03/05

Patent No. :6550701 B1  
Patent Issued :04/22/03  
Docket No. :CHAN3272/TJM  
Re: Request for Certificate of Correction

Consideration has been given your request for the issuance of a certificate of correction for the above-identified patent under the provisions of Rule(s) 1.322.

In the claims, (claim 4) Per Examiners request. Corrections not appropriate for Certificate of Correction. Reissue needs to be filed if changes needed. "Therefore, no correction(s) is in order here under United States Codes (U.S.C.) 254 and the Code of Federal Regulation (C.F.R.) 1322."

In view of the foregoing, your request is hereby denied

Charmaine Jackson  
For Cecelia Newman, Supervisor  
Decisions & Certificates  
Of Correction Branch  
(703) 305-8309 or (703)-305-5358

Thomas J. Moore  
625 Slaters Lane, Fourth Floor  
Alexandria, Virginia 22314

cj

**Exhibit A to Petition filed April 19, 2005 (U.S. Pat. No. 6,550,701)**

Exhibit B to Petition filed April 19, 2005, page 1 of 2 (U.S. Pat. No. 6,550,701)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re :  
Patent No.: 6,550,701 : Attention:  
Issued: April 22, 2003 : Certificate of Correction Branch  
Serial No.: 09/684,777 :  
Filed: October 10, 2000 :  
Attorney Ref: CHAN3272/TJM :

For: DUAL-FUNCTIONAL MEDIUM SHREDDING MACHINE STRUCTURE

**REQUEST FOR CERTIFICATE OF CORRECTION UNDER 37 CFR 1.322**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Pursuant to the provisions of 37 C.F.R. §1.322 Assignee of record, MICHILIN PROSPERITY COMPANY, LTD., respectfully requests correction by the U.S. Patent and Trademark Office (the "Office") of the above-identified U.S. patent by issuing the attached form PTO/SB/44, or in the alternative, by issuing a corrected patent.

The Office erred during examination by failing to require Claim 4 to be rewritten in independent format. Claim 4 is dependent on Claim 1. Claim 1 recites two switches, but Claim 4 recites "a single touch switch." Thus, Claim 4 literally has one less element than Claim 1. Only one switch is required (see the patent at column 4, line 32 and following).

Accordingly, it is respectfully requested that the attached Form PTO/SB/44 be duly certified and returned to the undersigned attorney at the earliest convenience of the Office.

The Commissioner is hereby authorized to charge any fees associated with this communication, or credit any overpayment to Deposit Account Number 02-0200.

Respectfully submitted,  
BACON & THOMAS, PLLC

October 20, 2004

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Alexandria, Virginia 22314  
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Email: mail@baconthomas.com  
Request for Certificate of Correction 2004 10 20.wpd


By:   
Thomas J. Moore  
Registration No. 28,974

Exhibit B to Petition filed April 19, 2005, page 1 of 2 (U.S. Pat. No. 6,550,701)

**BACON & THOMAS**

625 Slaters Lane 4th FL, Alexandria, VA 22314

PATENT NO. 6,550,701  
d April 22, 2003

JEN

Docket No. CHAN3272

Attorney: TJM

Due Date: 5/5/05

Serial No: 09/684,777

Filed: October 10, 2000

Applicant(s):

☒ MAILROOM☐ ART UNIT☐

Special Instructions:

The PTO stamp hereon acknowledges receipt of:

- |   |   |   |
|---|---|---|
| <input type="checkbox"/> Amendment/Response   | <input type="checkbox"/> Missing Parts Response w/Decl.   | <input type="checkbox"/> Request for Certificate of Correction under 37 CFR § 1.322 |
| <input checked="" type="checkbox"/> Check \$ 400.00                                       | <input type="checkbox"/> Appeal Brief (Triplicate)  | <input type="checkbox"/> Certificate of Correction                                  |
| <input type="checkbox"/> Issue Fee  | <input type="checkbox"/> Priority Documents(s)  | <input type="checkbox"/> Assignment   |
| <input type="checkbox"/> Preliminary Amendment  | <input type="checkbox"/> Notice of Appeal   |   |
| <input type="checkbox"/> 1 Mo. Extension of Time Petition                                 | <input type="checkbox"/> Substitute Declaration   |   |
| <input type="checkbox"/> Terminal Disclaimer  | <input type="checkbox"/> Information Disclosure Stmt. /references   |   |
| <input type="checkbox"/> Reply Brief (Triplicate)   | <input type="checkbox"/> Request for CPA  |   |
| <input type="checkbox"/> Sheets of Drawings -   | <input type="checkbox"/> Formal <input type="checkbox"/> Informal   |   |
| <input type="checkbox"/> Sm. Entity Statements -  | <input type="checkbox"/> Inv. <input type="checkbox"/> Sm. Bus. <input type="checkbox"/> Non-Inv. <input type="checkbox"/> Non-Profit | <input type="checkbox"/> Communication To:  |
| <input checked="" type="checkbox"/> PETITION TO THE DIRECTOR (including Exhibits A and B) |   |   |



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Filed By:

Exhibit B to Petition filed April 19, 2005, page 2 of 2 (U.S. Pat. No. 6,550,701)

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT NO. : 6,550,701

DATED : April 22, 2003

INVENTOR(S) : Frank CHANG

It is certified that an error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

Claim 4 is rewritten in independent format:

4. A dual-functional medium shredding machine structure, that allows shredding of paper, optical discs, and credit cards, characterized in comprising:

a machine body being provided with a power switch on a surface thereof and roller blades therein, the roller blades being driven by a gearbox;

two inports on an upper lid thereof, the inports including a paper inport with an opening of a larger dimension and inclined, curved channel walls, and a disc inport with an opening of a smaller dimension and vertical channel walls, the inports being each led to the shredding roller blades such that, regardless of the type of substance being fed by a user, the paper or the disc can all be shredded by the shredding roller blades through the intermeshing of roller blades; and

a single touch switch is provided between the roller blades such that regardless of the type of substance being fed by a user, the paper, disc, or credit cards can all touch the touch switch so as to activate the roller blades to perform shredding task while the scraps are all dispensed to an identical bin.

Mailing address of sender:

Patent No. 6,550,701

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No. of add'l copies  
@ .30 per page



Exhibit B to Petition filed April 19, 2005, page 2 of 2 (U.S. Pat. No. 6,550,701)